REMARKS/ARGUMENTS

I. Procedural History of Application and Current Status of the Claims

In the interests of keeping track of the extensive prosecution in this case, Applicants present a brief overview. This application was filed on April 14, 2004. The claims have been rejected on the merits four times now, the first time over the same primary references, and most recently over a newly cited reference.

In response to each of the first two rejections, Applicants amended the claims. In response to the third rejection, Applicants submitted declarations setting forth secondary evidence of non-obviousness. In the fourth office action, no acknowledgement was made of those declarations. However, given that the obviousness-based rejections were withdrawn, it is presumed that they were considered.

Now all 32 claims of the application stand rejected as being anticipated by U.S. Patent No. 6,181,837 to Cahill.

Here is a brief overview of the actions in this case:

- 2007-08-23 Office Action – All claims rejected over Anderson et al. in view of Dutta et al.
- 2007-12-05 Response Filed with Claim Amendment
- 2008-02-11 Final Office Action – All claims rejected over Anderson et al. in view of Dutta et al.
- 2008-04-08 Response Filed
- 2008-08-11 RCE Filed With Supplemental Amendment Suggested by Examiner
- 2008-10-01 Office Action – All claims rejected over Anderson et al. in view of Dutta et al. in further view of De Bonet.
- 2009-03-31 Response Filed with Secondary Evidence Declarations
- 2009-06-25 Office Action – All claims rejected as anticipated by U.S. Patent No. 6,181,837 to Cahill

Claims 1, 15, 21, and 31 have been amended to clarify that the downloadable index and/or archive of images is a *customer-specific* one. Support for this amendment is found in paragraphs 0043 and 0044 of the specification.

Claims 2 and 16 have been amended to further specify incorporating a corresponding account statement into the downloadable index. Support for this amendment is found in paragraphs 0045 and 0047 of the specification.

Claim 11 has been amended to clarify that the printed check has not yet been presented for payment. Support for this amendment is found in Fig. 3 and paragraph 0035.

Claim 17 has been amended to specify that the financial transaction software program is a

bookkeeping-type program that tracks a running balance of a checking account. Support for this amendment is found in Figs. 3 and 7 of the specification and the accompanying description.

II. Remarks

Applicants respectfully traverse the rejections. In order to anticipate a claim, a reference must teach each and every element of the claim. Cahill does not teach several elements of the claims.

A. Overview of Cahill

Before identifying the specific elements that Cahill fails to teach, it is instructive to understand what Cahill teaches.

The Cahill patent, filed on Nov. 18, 1994 and assigned to Chase Manhattan Bank, is remarkable for its recognition of the very long-felt needs and problems of the prior art. Cahill recognizes the difficultly and expense banks and their customers have long faced in *organizing, accessing*, *retrieving*, and *managing* cleared checks. But Cahill fell far short of solving those problems in an effective manner, much less in the particular manner that Applicants claim.

In the background section, Cahill observes that "[f]or *several decades* now the U.S. government has ... required that financial institutions maintain a seven year library ... of all checks deposited and/or paid from the institution's accounts" (1:32-37). Cahill also notes that many bank customers "maintain their own extensive check libraries" (2:15) to accommodate requests for proof of payment. Moreover, "[d]ue to the immense volume of stored information, the average turn-around time – the time elapsed from when the request is made until the copy is received – for fulfilling such requests can vary from a minimum of 24 hours to one to two weeks or more" (2:43-48). Accordingly, Cahill recognized – all the way back in 1994 – that "it is desirable to provide a system whereby a customer of the banking institution can request, retrieve, and display copies of checks, and, preferably, generate correspondence with a copy of a check, i.e., a check image, all without bank staff involvement" (3:5-10).

Cahill was filed *after* the dawn of the World Wide Web, and 2½ years *after* the release of Windows 3.1. The Mosaic browser – the first browser to display images inline with text and the browser credited with popularizing the World Wide Web – was released in 1993. Windows 3.1 – the first PC-based graphical user interface to become widely popular – was released in April 1992. Although Cahill makes no explicit reference to the "Internet," it describes a system in which check images are computer sorted by a host system 8 – which includes a sort station 2, an image storage station 5, and an output station 6 connected by an apparently internal network 3 – over a telephone line 11 and modem 10 to a customer workstation 7 (12:42-57; Figs. 1-3) hosting Windows' graphical user interface. Cahill clearly attempted to leverage the latest technology to deliver cleared check images to customers.

The elaborate detail in the Cahill patent – including several image screens – suggests that a real prototype was reduced to practice. Cahill, however, discloses a cumbersome user interface

and check image delivery system that – as explained in further below – fell far short of anticipating, much less providing the overall advantages of, the claimed invention. The bottom line is that Cahill's system failed to effectively satisfy the long felt needs to which Applicant's invention is directed.

The Cahill system had two very significant shortcomings: it was cumbersome and it was inefficient. But Cahill's failure to disclose solutions to these shortcomings is not surprising. Identifying, retrieving, transmitting, and organizing check image data – all the while maintaining data security – is a very complex, non-trivial process.[1] Truly, nothing is "easy" in this business.

Cahill disclosed a customer workstation or "image station 7" (12:42-45) comprising a computer 701, display device 701A, and a printer 703 (13:33-43). The customer workstation 7 provides a software-based user interface, including screens that allow the user to "initiate requests for check images, download those images to the customer workstation 7, and view or print the downloaded images as desired" (32:32-37).

Cahill's process for downloading a check image is exceptionally cumbersome. It begins with the user selecting the "Enter Check Request" menu option, which opens up a check request data entry sub-window (35:10-12; 38:15-21; 40:43-45; Figs. 10, 16). Then, the user serially enters in check requests – including at least a check number (41:23-24) – one at a time, into data entry fields 350 at the top of a "spread-sheet like screen" shown in Figs. 10 & 16 (40:30-34; 40:45-62), and confirms each individual check number request by selecting the "Add to List" control button 400 (41:31-35). To add the next check number, the user must first clear the data entry fields by clicking the "Clear Entry Fields" button 400 and then enter the next check number (42:5-7).

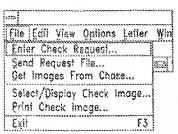


FIG. 7

FIG. 10

FIG. 16

Each time the user enters a check image request, the request is listed in the spread-sheet

[1] Cahill is notable for its elaborate detail on how cleared checks are sorted, scanned front and back, and processed. The process includes sending the check through an MICR reader to read and magnetically decode the MICR line of the check; digitally imaging the entire check and OCR'ing at least portions of the check; temporarily storing the check images; and merging the decoded MICR data and other metadata together with front and back images of a check into a single TIFF file (14:4-15:2). The process also includes an elaborate error-checking, error-repair, and sorting system (16:17-22:7). After a sufficient number of TIFF images are accumulated, they are grouped into a BLOB file containing as many as 50 or more TIFF files for long-term storage. The BLOB file location of each check image is then stored in an index record. Each BLOB file itself includes a header containing data (including the starting byte and byte length) locating each check TIFF image within the BLOB file (15:43-67; 27:16-28:65).

like section of the screen and recorded in a request file 720 which "contains the most recently compiled list of requests for transmission to the host system 8" (34:48-50).

Later, the user selects the "Send Request File" menu option (38:17-24), after which the workstation 7 is connected, via modem 10, to the host system 8. The user must then enter his user ID and password before the request file is transmitted to the host system 8 (22:47-49; 33:14-17; 36:4-67; 44:35-66). After sending the request, the communication session is terminated (36:65-57), and the "status field" in appropriate record 711 is updated to "pending" (37:1-4).

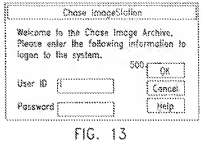


FIG. 13

After the host system 8 receives the request file, it adds the requests to a request queue 601 (22:51-55; Fig. 5C). Over time, the host system 8 reads the queue 601 in a first-in, first-out order, determines the location of the check image, and records the location of the requested check image in a request data structure (22:63-23:5; Fig. 5C). Next, a different process reads the request data structure, retrieves the TIFF image file 22 from the storage device and/or BLOB file where it is located, parses the TIFF file 22 into separate front (".f") and back (".b") image files – each retaining meta-data concerning the check data fields – and deposits them into an appropriate download directory (23:6-9; 25:45-27:7; 29:11-30:7; 31:31-53). The system also generates "Check Not Found" files in a TIFF image format, together with embedded meta-data identifying the requested check and account numbers, and deposits those in an appropriate download directory (27:8-14; 29:52-56).

Later, a user initiates a new communication session by selecting the "Get Images From Chase" menu option (38:17-31). This option initiates a new communication session between the workstation 7. Again, the user is required to enter his user ID and password (45:1-8). After successfully navigating through these security barriers for a second time, the host 8 sends a request to the host 8 to download previously requested check images. "If no checks have yet been retrieved from the archive, the host system transmits a message to inform the workstation that no checks are ready to download…." (45:17-20). If files are available for download, the host 8 notifies the user of their availability and the size of transmission and requests confirmation (37:8-14). If the request is confirmed, the host 8 transmits the files – one at a time – to the workstation using the Z-modem protocol (37:8-58; 45:9-44).

After the front and back check images are downloaded to the workstation 7, the workstation logs off, indicates that the download is completed, and prompts an "updating local database" message (45:44-52). During the updating process, the software scans each newly retrieved front and back TIFF image to extract the metadata about the check, including the account and check number. The workstation software then stores the extracted information in a main database file 710. The database file 710 contains a record 711 for each cleared check that has been requested or received, including the check number, amount, date, status, and front and back image file names (34:41-45; 35:17-38). Then, the front and back images are stored in an image subdirectory 702B (34:39-45; 35:44-46). The images are retained for a period of "between 1 and 31 days" before it appears on a "deletion list" (49:23-32; Fig. 23).

After the downloading procedure is complete, the workstation 7 returns the user to the main menu (Fig. 7). If the user selects the "Select/Display Check Image" menu option, the workstation produces the "Select/Display Check Images Screen" of Fig. 11.

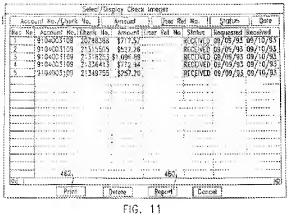


FIG. 11

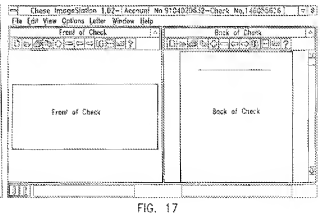


FIG. 17

Fig. 11 displays a sortable spreadsheet-like list of every check for which a check image request has been submitted, together with "information pertaining to that request" (45:61-63). The user can select one of the rows, and then press "Enter" key, causing a new display sub-window, shown in Fig. 17, to be launched to display the front and back check images (46:43-54).

Although Cahill is preoccupied with enabling an online-check-requesting system that is limited to manually entered requests for images of one cleared check at a time, Cahill does disclose a method for bulk export of check images. In particular, Cahill discloses an "export station 610" with a "bulk export controller" that can write check images to a suitable computer readable medium, such as a tape drive or CD, "for the large scale delivery or transmission of check images to customers who must process requests for large numbers of checks or who require … that all checks paid by them be provided to them" (13:59-14:3; 30:38-50). Indeed, this is *still* the way most banks deliver check images to their high-check-volume customers.[2]

In summary, Cahill's system is overly cumbersome. It requires users to enter check requests serially (*but see* fn 2); log on; enter their user ID and password; transmit a check request file; log off; wait for the host 8 to process the request; log back on; re-enter their user ID and password; and then download the check images.

Cahill's system is also inefficient. It describes a process in which front and back check images are generated, merged into a single TIFF file, further merged into a BLOB file, indexed by the host system 8, then extracted from the BLOB file, split into front and back check images

[2] Cahill does – ever so briefly and apparently as an afterthought – suggest that check images could be downloaded in bulk, without a request (46:14-16), or based on a "standing order" (4:25-27; 6:24-29), but Cahill does not explain how such an order would be initiated or how such a transaction would be processed. There is no hint of this functionality in either the screenshots displayed in the Cahill patent, or in any of the menu options described in columns 38 and 39. Cahill made no attempt to provide an enabling disclosure for this nontrivial concept.

again, and transmitted serially to the customer's workstation. Then, the workstation re-indexes the check images and incorporates them into a new local database.

B. Cahill does not teach the following elements of the claims:

1. Cahill does not generate a downloadable archive or searchable index of cleared paper check images

Cahill does not teach providing a software program to a financial institution for use on a first computer serving the institution, the software program being operable to generate a downloadable customer-specific archive of cleared paper check images and/or searchable index of those checks (claims 1, 15, 21, 31).

The Examiner asserts that Cahill teaches this element at 2:16-40. But in fact, 2:16-40 only discusses how financial institutions frequently maintain *physical* archives of checks in microfilm.

The Examiner might have cited 5:19-21's "electronic host archive storage and retrieval system for storing and retrieving copies of checks or check images." But Cahill clearly does not teach generating downloadable *customer-specific* archives or search indices of the check images.

Rather, Cahill teaches generating large BLOBs of TIFF files as check images are scanned in (14:58-15:67) and generating a massive index of all the cleared checks. Accordingly, both the BLOBs and the index will ordinarily span multiple customer accounts.

Moreover – as discussed in the Cahill summary – Cahill teaches transmitting front and back check images serially, as individual files, one at a time. Cahill does not teach generating a *downloadable* archive of those checks.

Cahill also does not teach generating downloadable searchable customer-specific indices of cleared checks. Rather, Cahill teaches having the customer-level workstation generate and/or update a database after the individual check images have been downloaded.

2. Cahill does not teach providing customers with complementary software that downloads archives and searchable indices of cleared paper check images.

Cahill also does not teach providing customers with complementary software that downloads archives and/or searchable indices of cleared paper check images (claims 1, 15).

The Examiner asserts that Cahill teaches this element at 5:21-6:30. But in fact, as explained in the extensive Cahill summary above, Cahill teaches downloading individual front and back check images, serially, one at a time. Cahill also does not teach downloading searchable indices of the check images.

3. Cahill does not teach providing a transaction bookkeeping software program for use on a computer that includes a checking account ledger for recording the customer's checking account transactions.

The Examiner's office action doesn't even acknowledge the special limitations of claim 6, which includes providing the checking account customer with a transaction bookkeeping software program for use on a computer that includes a checking account ledger for recording the customer's checking account transactions.

Related limitations also appear in claims 17, 25 and 26. Claim 17 recites "a financial transaction bookkeeping software program residing on the customer's personal computer, the financial transaction bookkeeping software program being operable to maintain a database of the customer's financial transactions and track a running balance of a checking account, the financial transaction software program being further operable to store the downloaded index together with the cleared check images; wherein the index downloading software module is integrated with the financial transaction software program."

Claim 25 recites that "the computer program is a financial bookkeeping software program operable to maintain a record of all account transactions affecting the customer's account's balance in an account register." Claim 25 depends from claim 24, which recites "providing the account customer with a computer program...." Claim 26 depends from claim 25 and recites "wherein the financial bookkeeping software program associates the downloaded cleared check images with an associated account transaction in the account register."

A ledger is a record of transactions and/or accounts, each recorded individually *with its balance*. Cahill's workstation system (see Fig. 11, a few pages back) is not a financial bookkeeping system. It is does not include a checking account ledger that tracks the balance in the checking account. Rather, Cahill's workstation system simply reports the amounts of a few checks that have been individually selected for download.

A similar limitation appears in claim 4, which recites "providing the customer with a checking account ledger for recording the customer's checking account transactions; wherein the complementary software is operable to record financial transactions in the checking account ledger corresponding to the check images in the downloadable index."

The Examiner asserts that Cahill's Fig. 5 (reproduced below) discloses the limitations of claim 4.

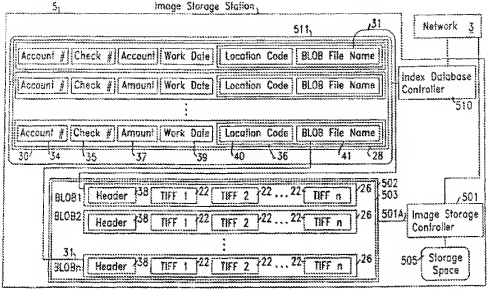


FIG. 5

Cahill clearly discloses that Fig. 5 is a "detailed diagram of one embodiment of part of the *host system* showing how check images are stored in/retrieved from the mass storage device of the host archive system." (11:15-18). This host system serves and maintains a database of check images and corresponding account, check, and amount numbers for *all* of the bank's customers and accounts. This host system is *not* a bookkeeping system or checking account ledger for customers.

4. Cahill does not teach incorporating multiple cleared paper checks into a single downloadable file.

Cahill does not teach incorporating multiple cleared paper check images into a downloadable index (claim 2) or into a downloadable single file archive (claim 16). Nor does it teach providing downloadable digital archives where each archive contains the images of multiple cleared paper checks (claims 1, 15, 21, 31).

The Examiner asserts that Fig. 27 of Cahill "teaches archive of images of multiple cleared paper checks is incorporated into the downloadable index." Fig. 27 is reproduced to the right. There is nothing either in Fig. 27 or the accompanying description to support the Examiner's assertion. In fact, the accompanying description (35:17-52) reiterates that separate front and back check images are downloaded serially, one at a time.

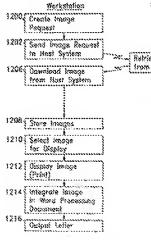


FIG. 27

5. Cahill does not teach incorporating a corresponding account statement into the downloadable index

Cahill does not teach incorporating a corresponding account statement into the downloadable index. This is a newly added limitation to claims 2 and 16, so the Examiner has not yet had the opportunity to review this limitation.

6. Cahill does not teach "comparing the prerecorded information with the downloaded transaction information, and alerting the customer if there is a mismatch between the prerecorded information and the downloaded transaction information."

Claim 10 recites that the method further comprises the step of comparing prerecorded transaction information with downloaded transaction information and alerting the customer if there is a mismatch.

The Examiner asserts that this limitation is taught by Cahill 54:21-34.

Cahill 54:21-34 is simply the first few lines of claim 1, and the language therein does not remotely suggest this limitation. Elsewhere, Cahill teaches that the non-image tag fields in the downloaded TIFF files are used to associate the .f and .b front and back image files with the requests (53:56-54:2). But the undersigned could find nothing in Cahill indicating that a comparison is made to find a mismatch and alert the customer if a mismatch is found.

Claim 28 recites a related element: "wherein the financial bookkeeping software program is operable to compare information about a cleared check image in a downloaded archive with prerecorded information about the cleared check."

The Examiner refused to even acknowledge the limitations of claim 28 by grouping it with claims 18 and 26-27. The Examiner cited only Cahill Fig. 25 against claim 28. Fig. 25, shown on the next page, does not disclose the limitations of claim 28. Applicant has also searched Cahill and found nothing that would anticipate claim 28.

6. Cahill does not teach "printing a check through the financial transaction bookkeeping software, and prerecording the financial transaction based on the information printed on the check."

Claim 11 recited "printing a check through the financial transaction bookkeeping software, and prerecording the financial transaction based on the information printed on the check."

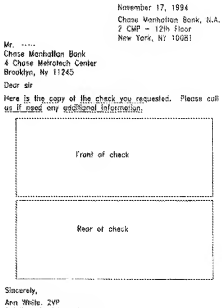
The Examiner asserts that this limitation is taught by Cahill at 38:32-35 and Fig. 27.

The passage at 38:37-38 discloses a "Print Check Image" option, but this option only enables printing of a *cleared* check image.

Applicants have amended claim 11 to clarify that the check "has not yet been presented for payment." Support for this amendment is found in Fig. 3 and paragraph 0035.

7. Cahill does not teach "receiving an image of a check before it has cleared; running an optical character recognition process on the check image to identify transactional textual information on the check image; and prerecording the financial transaction corresponding to the check by storing the optically-recognized transactional textual information in the customer's checking account ledger."

Claim 12 recites: "receiving an image of a check before it has cleared; running an optical character recognition process on the check image to identify transactional textual information on the check image; and prerecording the financial transaction corresponding to the check by storing the optically-recognized transactional textual information in the customer's checking account ledger."


November 17, 1994
Chase Manhattan Bank, N.A.
2 CMP – 12th Floor
New York, NY 10081

Mr. ____
Chase Manhattan Bank
4 Chase Metrotech Center
Brooklyn, NY 11245

Dear sir

Here is the copy of the check you requested. Please call us if need any additional information.

Front of check

Rear of check

Sincerely,
Ann White, 2VP
Relationship Administrator
Chase Manhattan Bank, N.A.

FIG. 25

The Examiner asserts that Cahill Fig. 25 recites this element. But Fig. 25 is simply a printout of a *cleared* check. Cahill Fig. 25 does not anticipate claim 12.

Cahill 14:22-67 discusses OCR'ing cleared checks as part of the bank's cleared check imaging process. But the undersigned could find nothing anywhere in Cahill teaching OCR'ing a check *before* it clears.

Claim 13 recites a related limitation: "the financial transaction bookkeeping software program is integrated with an optical character recognition module operable to identify typed or written information in a cleared check image."

The Examiner asserts that Cahill Fig. 27 teaches this element. Fig. 27 discloses *neither* optical character recognition *nor* a financial transaction bookkeeping software program, much less that they are integrated.

8. Cahill does not teach "prerecording a financial transaction corresponding to a check; downloading an image of the check after it has cleared; running an optical character recognition process on the check image to identify typed or written information on the check image; comparing the prerecorded information with the optically recognized information; and alerting the customer if there is a mismatch between the prerecorded information and the optically recognized information."

Claim 14 recites: "prerecording a financial transaction corresponding to a check; downloading an image of the check after it has cleared; running an optical character recognition process on the check image to identify typed or written information on the check image; comparing the prerecorded information with the optically recognized information; and alerting the customer if there is a mismatch between the prerecorded information and the optically recognized information."

The Examiner asserts that Cahill Fig. 25 teaches this element. But Fig. 25 is simply a printout of a cleared check. Cahill Fig. 25 does not anticipate claim 14.

7. Cahill does not teach "means for detecting possible check washing fraud"

Claim 20 recites: "means for detecting possible check washing fraud." Corresponding structure for this element is set forth in Fig. 3 and the accompanying description of the specification.

The Examiner asserts that Cahill 3:60-63 teaches this element. Cahill 3:53-60 states that "It is furthermore an object of the invention to provide at the financial service customer's request, a system with the ability on a daily basis to scan a customer's paid checks … for the customer service investigation functions … [of] signature verification, check fraud evaluation, …. etc."

Cahill is not proposing a system that detects possible fraud on its own. Cahill is simply proposing an imaging system to facilitate a *customer's* ability to perform a manual "check fraud evaluation." Therefore Cahill does not anticipate claim 20.

8. Cahill does not teach "e-mailing the account customer a notice after a digital archive has been generated"

Claim 22 recites: "e-mailing the account customer a notice after a digital archive has been generated."

The Examiner, by grouping claim 22 with claim 4, did not acknowledge the existence of this element. The Examiner impliedly asserted that Cahill teaches this element at Fig. 5. Fig. 5 does not disclose or teach e-mail. The undersigned searched for the terms "e-mail," "email,"

"notice," and "notif*" in Cahill and found nothing that would anticipate this element.

9. Cahill does not teach that "the e-mail contains a link to a web page that enables the account customer to enter a password in order to obtain secure online access to the digital archives."

Claim 23 depends from claim 22 and recites that "the e-mail contains a link to a web page that enables the account customer to enter a password in order to obtain secure online access to the digital archives."

The Examiner, by grouping claim 23 with claim 20 ("means for detecting … fraud"), did not acknowledge the existence of this element. The Examiner impliedly asserted that Cahill teaches this element at 3:60-63.

Applicant searched Cahill and found nothing that would anticipate this element.

10. Cahill does not teach: "providing HTML files to encapsulate the cleared check images; generating searchable indexes of the HTML files; and incorporating the searchable indexes into the digital archives."

Claim 29 recites: "providing HTML files to encapsulate the cleared check images; generating searchable indexes of the HTML files; and incorporating the searchable indexes into the digital archives."

The Examiner did not even acknowledge the limitations of claim 29, instead grouping it with claim 19. The Examiner also asserted that Cahill Figs. 25 and 26 recite these elements.

Cahill doesn't even mention HTML, much less encapsulating cleared check images within HTML files. It doesn't mention making searchable indices of HTML files. And it doesn't mention incorporating searchable indices into downloadable digital archives.

III. Conclusion

Applicants noted this in the previous response and reiterate it here again: the MPEP cautions that "it is to the interest of the applicants as a class as well as to that of the public ***that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits***." MPEP § 706.07 (emphasis added). The MPEP also provides that "the invention as disclosed and claimed should be thoroughly searched ***in the first action*** and the references fully applied," and that "[s]witching … from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will … tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection." MPEP § 706.07 (emphasis added).

Applicants respectfully submit that the foregoing arguments are fully responsive to the June 25, 2009 Office Action and are sufficient to put the claims in a condition for allowance. Should the Examiner desire to sustain any rejections, the courtesy of a telephone conference between the Examiner, the Examiner's supervisor, and the undersigned attorney at (719) 689-0700 is respectfully requested in advance.

The undersigned respectfully requests that the application be allowed and passed to issue.

Respectfully submitted,

Date: Aug. 18, 2009

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